

### **REMARKS/ARGUMENTS**

All pending claims stand rejected under 35 U.S.C. § 103(a). Applicants respectfully request reconsideration and allowance of all pending claims.

#### **A. Claims 1-2 and 9-10 Rejected Under 35 U.S.C. § 103(a)**

Claims 1-2 and 9-10 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,993,210 to Pine (hereinafter, "Pine") in view of U.S. Patent No. 5,742,037 to Scola et al. (hereinafter, "Scola"). Applicants respectfully traverse.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. \_\_\_, 2007 U.S. LEXIS 4745, at \*\*4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references "must teach or suggest all the claim limitations." M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at \*\*37. "[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Claim 1 is directed to "a method for concurrent image capture and decoding." The method is implemented by a "graphical code reader." Claim 1 recites "capturing a first image," "processing the first image," and "capturing a second image while the first image is being processed." Claim 1 defines "processing the first image" as "searching for a graphical code within the first image and attempting to decode the graphical code." Thus, in accordance with claim 1, a "graphical code reader ... captur[es] a second image while" "attempting to decode the graphical code" in "a first image." The cited references do not teach or suggest this subject matter.

The Examiner correctly acknowledges that Pine does not teach or suggest “searching for a graphical code within the first image and attempting to decode the graphical code.” (See Office Action, page 2.) However, the Examiner asserts that this subject matter is taught by Scola. (See *id.*) Applicants respectfully disagree. Scola does not teach or suggest “attempting to decode the graphical code.” In fact, the word “decode” (or variations thereof) is not used anywhere in Scola.

Scola states: “The invention is directed to a method and apparatus for identifying an object having an identifying feature.” (Scola, col. 2, lines 2-3.) Scola also states: “An identifying feature is a feature that serves to identify and distinguish one object from another. Examples of identifying features include part number indicia, barcodes and universal product codes (UPC) as well as trademarks and other logos.” (Scola, col. 4, lines 21-25.) Thus, Scola describes a method for “identifying an object having an identifying feature,” where an “identifying feature” could be a barcode. However, Scola does not teach or suggest “attempting to decode the graphical code,” as recited in claim 1. Merely identifying a graphical code is not the same as “decod[ing] the graphical code,” as claimed.

Scola also states: “The scanning process includes the step of acquiring one or more image frames of the object at 310. Each sampling location is evaluated in sequence until a barcode match is found.” (Scola, col. 9, lines 59-62.) Thus, Scola describes finding a “barcode match.” However, Scola does not teach or suggest “attempting to decode the graphical code,” as recited in claim 1.

Scola also states: “The method of identifying the object includes training the system to identify and store reference characteristic information of that barcode and scanning objects to verify that they include the identifying barcode.” (Scola, col. 8, lines 5-8.) Thus, the method described by Scola includes verifying that objects include an “identifying barcode.” However, Scola does not teach or suggest “attempting to decode the graphical code,” as recited in claim 1.

Thus, even assuming that one skilled in the art would have combined the references in the manner proposed by the Examiner (which is not conceded), the proposed combination would not teach or suggest all of the subject matter recited in claim 1. In particular, the Examiner’s combination of Pine and Scola does not teach or suggest a “graphical code reader ... capturing a

second image while” “attempting to decode the graphical code” in “a first image,” as recited in claim 1.

For at least the foregoing reasons, Applicants respectfully submit that claim 1 is allowable. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claim 2 depends from claim 1. Claim 9 includes subject matter that is similar to the subject matter discussed above in relation to claim 1. Claim 10 depends from claim 9. Accordingly, Applicants respectfully request that the rejection of claims 2 and 9-10 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

B. Claims 3-6, 8, 11-14 and 16 Rejected Under 35 U.S.C. § 103(a)

Claims 3-6, 8, 11-14 and 16 stand rejected under 35 U.S.C. § 103(a) based on Pine in view of Scola and further in view of U.S. Patent No. 7,197,749 to Thornton et al. (hereinafter, “Thornton”). Claims 3-6 and 8 depend from claim 1. Claims 11-14 and 16 depend from claim 9, which includes subject matter that is similar to the subject matter discussed above in relation to claim 1. Accordingly, Applicants respectfully request that the rejection of claims 3-6, 8, 11-14 and 16 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

C. Claims 7 and 15 Rejected Under 35 U.S.C. § 103(a)


Claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) based on Pine, Scola and Thornton and further in view of U.S. Patent No. 5,473,741 to Neufelder (hereinafter “Neufelder”). Claim 7 depends from claim 1. Claim 15 depends from claim 9, which includes subject matter that is similar to the subject matter discussed above in relation to claim 1. Accordingly, Applicants respectfully request that the rejection of claims 7 and 15 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

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D. Conclusion

Applicants respectfully assert that all pending claims are allowable over the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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